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OFFICE OF PETITIONS

In re Application of
Pellegrini
Application No. 09/736,134
Filed: December 15, 2000
For: SYSTEM THAT TRANSFERS ASSET
OWNERSHIP USING A PROBABILISTIC MODEL

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: ON PETITION
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This is a decision on the petition filed October 4, 2005, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The delay in treating this petition is sincerely regretted.

The petition considered under 37 CFR 1.181 is **granted**.

Petitioner requests that the holding of abandonment be withdrawn in that an RCE, a submission within the meaning of 37 CFR 1.114 and 1.111, and a one month extension of time were filed January 19, 2005, in reply to the final Office action of October 8, 2005.

A review of the record reveals that a non final Office action was mailed March 5, 2004. The action contained a rejection of claims 1 through 23 under 35 U.S.C. § 112, ¶ 1, as lacking description; a rejection of claims 1 through 23 under 35 U.S.C. § 112 ¶ 2, as indefinite; a rejection of claims 10 through 13 under 35 U.S.C. § 101; and a rejection of claims 1 through 23 under 35 U.S.C. § 103(a) over Kanter (U.S. 5,537,314).

On June 3, 2004, applicant filed a reply under 37 CFR 1.111 and requested reconsideration of all the rejections. While the examiner did not find the reply persuasive for purposes of overcoming the rejections and issued a final office action on October 8, 2005, the examiner did not hold the reply to be non-compliant with 37 CFR 1.111 for purposes of addressing the rejections and requesting reconsideration. The final Office action repeated the rejections of claims 1 through 23 under 35 U.S.C. § 112, ¶ 1, as lacking description; a rejection of claims 1 through 23 under 35 U.S.C. § 112 ¶ 2, as indefinite; a rejection of claims 10 through 13 under 35 U.S.C. § 101; and a rejection of claims 1 through 23 under 35 U.S.C. § 103(a) over Kanter (U.S. 5,537,314).

Petitioner asserts that a submission within the meaning of 37 CFR 1.114 and 1.111, and a one month extension of time were filed January 19, 2005, in reply to the final Office action of October 8, 2005. Petitioner further asserts that the requirement for a submission was met in this instance by referring or incorporating the June 4, 2004, reply in the RCE request, since as petitioner asserts, the rejections were identical to those previously made, and as the examiner considered the previous reply acceptable—but non persuasive, such constituted an adequate reply for the purposes of the RCE. Petitioner further notes that the USPTO has never held the submission or RCE defective on the written record.

Inspection of USPTO records for this application reveals a less than exemplary written record trail for this application. PALM records would appear to indicate that this application was held abandoned on June 27, 2005, and that a Notice of Abandonment was apparently mailed August 18, 2005. However, the Image File Wrapper (IFW) record, which is the official USPTO record for the contents of this application, do not reflect or correspond to those PALM entries. Nevertheless, the requirement in 37 CFR 1.2 that all business before the USPTO is to be transacted in writing, binds the employees of the USPTO as surely as it binds the applicants

and their registered representatives. Thus, there is simply no basis in or on the written record for any holding of abandonment. This is further reinforced by the failure of the written record to show that the examiner has even considered the submission filed with the RCE, much less held the submission to not meet the requirements of 37 CFR 1.111. As explained on the USPTO's own web site at <http://www.uspto.gov/web/offices/dcom/olia/aipa/rcefaq.htm>:

A12. What if a RCE is filed with a submission and the required fee after final rejection but the submission does not meet the reply requirements of 37 CFR 1.111?

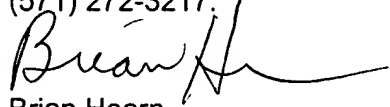
If reply to an Office action is outstanding and the submission is not fully responsive to the prior Office action, then it must be a bona fide attempt to provide a complete reply to the prior Office action in order for the RCE to toll the period for reply. If the submission is a bona fide attempt to provide a complete reply, applicant should be informed that the submission is not fully responsive to the prior Office action, along with the reasons why, and given a new shortened statutory period of one month or thirty days (whichever is longer) to complete the reply. See 37 CFR 1.135(c). If the submission is not a bona fide attempt to provide a complete reply, the RCE will not toll the period for reply and the application will be abandoned after the expiration of the statutory period for reply.

Since, as petitioner argues with considerable force, the examiner has not held the submission filed June 3, 2004 to be not compliant with 37 CFR 1.111 with respect to the identical rejections set forth in the non final Office action, it is not apparent how, even *sub silentio*, that same reply could reasonably be considered to not be compliant with 37 CFR 1.111 with respect to the same rejections in the final Office action. In any event, the IFW record of the USPTO fails to provide any written record of the treatment of the RCE and its submission by the examiner.

Accordingly, any holding of abandonment for this application simply lacks any, much less an adequate, basis in the written record of the USPTO for this application. The holding of abandonment must be, and is, withdrawn. The Notice of Abandonment is **vacated** as mailed in error.

This application is being referred to the Technology Center for consideration of the RCE and the accompanying submission on the record.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions